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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/022,411      | 12/20/2001  | Lain-Tze Lee         | LEEL3002/EM         | 5019             |

23364 7590 06/19/2003

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EXAMINER

KILLOS, PAUL J

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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| EXAMINER |
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DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☐ This application has been examined    ☐ Responsive to communication filed on \_\_\_\_\_    ☐ This action is made final.

A shortened statutory period for response to this action is set to expire Three month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |   |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.                 | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.     | 6. <input type="checkbox"/> _____   |

Part II SUMMARY OF ACTION

1. ☐ Claims 1-24 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☐ Claims 1-4, 7, 9, 13 19-24 are rejected.
5. ☐ Claims 5, 6, 8, 10, 11, 12 and 14-18 are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_ Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_ has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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# STATEMENT OF STATUTORY BASIS, 35 USC 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

## 102(b) ACTIVITY MORE THAN ONE YEAR PRIOR TO FILING

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

## REJECTION 35 USC 102 (b) PATENT OR PUBLICATION

Claims 1-4, 7, 9, 13, 19-22, 23 and 24 rejected under 35 U.S.C. 102(b) as being anticipated by WO 91/00265 published 10 January 1991.

The reference teaches the compounds of the claims <sup>recited</sup>~~set out~~ above, their pharmaceutical properties as anticancer agents and method for preparation.

## UTILITY REJECTION UNDER 35 U.S.C 101 AND 35 U.S.C 112 FIRST PARAGRAPH

Claim 22 is rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific asserted utility a credible or a well established utility.

Sufficient evidence or experimentation is lacking in the specification to show that the claimed compound can cure a patient with AIDS. Because such utility for the claimed invention is not specific for the reasons set forth above, credibility cannot be asserted.

Claim 22 is also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific asserted utility a credible, sufficient evidence by experimentation for curing a patient with AIDS or a well

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established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

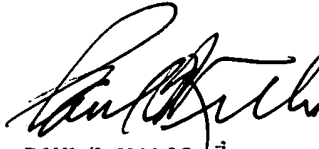
Claims 5, 6, 8, 10, 11, 12, 14-18 are objected to as being dependent on rejected claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Killos whose telephone number is 703-308-0135. The examiner can normally be reached on Tuesday-Friday; alternate Mondays 9 am-3 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 703-308-4532. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Killos/tgd  
June 12, 2003

  
PAUL J. KILLOS  
PRIMARY EXAMINER  
AU. 1623